



10 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Robert D. Traver
SHERIDAN ROSS P.C.
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141

In re Application of
RHODES *et al*
U.S. Application No.: 09/831,579
PCT No.: PCT/AU99/00917
Int. Filing Date: 22 October 1999
Priority Date: 18 November 1998
Attorney Docket No.: 1037BP-1
For: BIO-OXIDATION PROCESS AND
APPARATUS

**DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(a)**

This decision is in response to applicants' "Renewed Petition Under 37 C.F.R. 1.47(a)" ("Ren.Pet.") submitted 02 July 2002.

BACKGROUND

On 17 May 2002, a decision dismissing applicants' petition was mailed because applicants failed to meet items (2) and (4) of 37 CFR 1.47(a).

On 02 July 2002, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a new declaration.

DISCUSSION

The decision dated 17 May 2002 declared that applicants failed to satisfy item (2) of 37 CFR 1.47(a). Specifically, the decision concluded that "[t]he supporting documentation submitted with the petition does not provide clear evidence that Mrs. Winby's conduct constitutes a refusal." Further, the decision clarified that "Mrs. Winby's 'reluctance,' as set forth in the supporting declaration, to sign the necessary papers coupled with the supporting declarations showing that Mrs. Winby has not given an express oral or written refusal to accept the papers and sign the papers does not clearly constitute a 'refusal' as set forth in MPEP 409.03(d).

In this renewed petition, applicants argue that the conduct of Mrs. Winby constitutes a refusal to sign the documents based on the facts listed in the declaration of Richard H. Baddeley at page 2, numbered 9(a)-(d). Ren.Pet. at ¶ 4. Applicants assert that "[i]t was not the original expressions of reluctance to sign the documents noted by the PCT Legal Office, but these repeated expressions followed by her failure to sign and return the documents when presented with the application papers and sufficient time to examine the documents and respond by returning the signed

documents.” *Id.* at ¶ 6. Applicants base their conclusion on guidance provided in section 409.03(d) of the MPEP which states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The documentary and declaratory evidence of Mr. Baddeley and Dr. Miller provided in the initial petition has been reviewed *de novo* concentrating on the overall behavior of Mrs. Winby and how this conduct constitutes a refusal pursuant to the regulations above.

After review of all pertinent documents, it is concluded that the conduct of Mrs. Winby constitutes a refusal to join as outlined in the MPEP. Item (2) of 37 CFR 1.47(a) is now satisfied.

The prior decision also stated that applicants failed to satisfy item (4) of 37 CFR 1.47(a) because the declaration submitted did not comply with the requirements of 37 CFR 1.497(a) and (b). Specifically, the declaration did not provide the citizenship, residence and mailing address of the legal representative, Mrs. E.A. Winby.

In the renewed petition, applicants submitted a declaration signed by two of the three listed co-inventors. The citizenship of the deceased co-inventor is listed as required by 37 CFR 1.497(a)(3). The nonsigning legal representative's name, residence, post office address and citizenship are also typed on the declaration pursuant to 37 CFR 1.497(b)(2). This declaration satisfies the requirements of section 409.03(a) of the MPEP and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has now been satisfied.

Accordingly, all the requirements of 37 CFR 1.47(a) are complete.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The papers have also been **ACCEPTED** pursuant to 37 CFR 1.42.

Applicants have completed the requirements for acceptance under 35 U.S.C.

371(c). The application has an international filing date of 22 October 1999 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 02 July 2002.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



Richard Cole
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457